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09/750,142	12/29/2000	Stephane Bouet	017.39113X00	6770

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EXAMINER

PHAN, TAM T

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/750,142

Applicant(s)

BOUET, STEPHANE

Examiner

Tam (Jenny) Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/20/2005 has been entered. Claims 1 and 22 are currently amended.
2. Claims 1-45 are presented for examination.

### *Priority*

3. No priority claims have been made.
4. The effective filing date for the subject matter defined in the pending claims in this application is 12/29/2000 (29 December 2000).

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reisman (U.S. Patent Number 6,594,692) in view of Nobakht et al. (U.S. Patent Number 6,587,873), hereinafter referred to as Nobakht.
7. Reisman disclosed a media content delivery system comprising: a system database for storing a plurality of media files (Abstract, Figure 1); a user input device for

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selecting selected media files from the plurality of media files in said database to be outputted (Abstract, Figure 1, column 20 lines 57-65, column 21 lines 19-24); an output device for outputting the selected media files; an external data interface for receiving media file for storage in the system database (Abstract, Figures 1, 7, 12, column 10 lines 52-67), and a media content delivery system controller responsive to selection by said user input device of at least one of the selected media files stored in said database, to apply the at least one selected media file to said output device for outputting (Abstract, Figures 1 & 12, column 20 lines 57-65, column 21 lines 19-24)

8. Reisman did not expressly teach an integrated circuit card interface adapted to hold an integrated circuit card having encoded thereon criteria for accepting the received media files for storage in said database; and in responsive to receipt by said external data interface of media files, to compare each of the received media files received from the external data interface with the criteria from the integrated circuit card, and the controller control is further adapted to store in said system database the received media files received by said external data interface which meet criteria on an integrated circuit card held in said integrated circuit card interface; and wherein the plurality of media files stored by the system database are not stored in the integrated circuit card.

9. Reisman suggested exploration of art and/or provided a reason to modify the delivery system with other storage devices such as the integrated circuit (IC) card to enable flexible and appropriate online service charging mechanism for online media products (column 2 lines 39-48, column 10 lines 52-67, column 29 line 62-67, column 62 lines 29-32).

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10. Nobakht disclosed a system for selectively updating the terminal database [channel table database] having an integrated circuit card interface adapted to hold an integrated circuit card [smart card] having encoded thereon criteria for accepting the received media files for storage in said database (Figures 2, 3B, 4, column 4 lines 51-65, column 6 lines 34-49); and in responsive to receipt by said external data interface of media files, to compare each of the received media files received from the external data interface with the criteria from the integrated circuit card (Figure 3B, column 8 line 64-column 9 line 10, column 9 lines 36-51, column 12 lines 50-65), and the controller control is further adapted to store in said system database the received media files received by said external data interface which meet criteria on an integrated circuit card held in said integrated circuit card interface (Figure 3B, column 8 line 64-column 9 line 10, column 9 lines 36-51, column 12 lines 50-65); and wherein the plurality of media files stored by the system database are not stored in the integrated circuit card (Figures 2, 3B, 4, column 5 lines 35-40, column 7 lines 23-41).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the delivery system of Reisman with the teachings of Nobakht to include the IC card feature in order to offer user greater flexibility because IC cards would have the function for preventing unauthorized reading from and/or writing to system database (Nobakht, Figure 3B, column 6 lines 42-49) since online services are oriented to extended online sessions which require complex user interaction (Reisman, column 2 lines 24-30).

12. Regarding claim 2, Nobakht disclosed a media content delivery system wherein said user input device comprises a keyboard (Figure 4).

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13. Regarding claim 3, Reisman disclosed a media content delivery system wherein said user input device comprises a mouse (column 22 lines 43-51).

14. Regarding claim 4, Reisman disclosed a media content delivery system wherein said user input device comprises an electronic interface (Figure 12).

15. Regarding claim 5, Reisman disclosed a media content delivery system wherein said output device comprises a video output device (Figure 12, column 57 lines 47-65).

16. Regarding claim 6, Reisman disclosed a media content delivery system wherein said output device comprises an audio output device (Figure 12, column 57 lines 47-65).

17. Regarding claim 7, Reisman disclosed a media content delivery system wherein said output device comprises an electronic interface (Figure 12, column 57 lines 47-65).

18. Regarding claim 8, Reisman disclosed a media content delivery system wherein said external data interface comprises a wire connection (Figure 12, column 30 lines 1-4).

19. Regarding claim 9, Reisman disclosed a media content delivery system further comprising a server connected to said wire connection (Figure 12, column 30 lines 1-4).

20. Regarding claim 10, Reisman disclosed a media content delivery system further comprising a computer connected to said server (Figure 12).

21. Regarding claim 11, Reisman disclosed a media content delivery system wherein said external data interface comprises a wireless connection (column 5 lines 39-47, column 30 lines 1-4).

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22. Regarding claim 12, Reisman disclosed a media content delivery system further comprising a server connected to said wireless connection (column 5 lines 39-47, column 30 lines 1-4).

23. Regarding claim 13, Reisman disclosed a media content delivery system further comprising a computer connected to said server (Figure 12, column 5 lines 39-47).

24. Regarding claim 14, Reisman disclosed a media content delivery system wherein said external data interface comprises a compact disc raid only memory drive (Figure 12, column 57 lines 47-65).

25. Regarding claim 15, Reisman disclosed a media content delivery system wherein said external data interface comprises a digital video disc drive (Figure 12, column 57 lines 47-65).

26. Regarding claim 16, Reisman disclosed a media content delivery system wherein said external data interface comprises a computer disk drive (Figure 12, column 57 lines 47-65).

27. Regarding claim 17, Reisman and Nobakht combined disclose a media content delivery system, wherein said integrated circuit card interface is adapted to hold an integrated circuit card having encoded thereon criteria identifying an e-mail address, and said external data interface is adapted to receive email for the identified e-mail address (Reisman, column 55 lines 53-53; Nobakht, Figure 3B, column 6 lines 13-14, column 8 line 64-column 9 line 10).

28. Regarding claim 18, Nobakht disclosed a media content delivery system further comprising an integrated circuit card having encoded thereon criteria for accepting media files for storage in said database (Figure 3B, column 8 line 64-column 9 line 10).

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29. Regarding claim 19, Reisman disclosed a media content delivery system wherein the criteria are encrypted (column 8 lines 24-38).

30. Regarding claim 20, Reisman and Nobakht combined disclose a media content delivery system wherein the criteria include an e-mail address (Reisman, column 55 lines 53-53; Nobakht, Figure 3B, column 6 lines 13-14, column 8 line 64-column 9 line 10).

31. Regarding claim 21, Reisman and Nobakht combined disclose a media content delivery system further comprising a kiosk housing, said database, said user input device, said output device, said integrated circuit card interface, said external data interface, and said controller (Reisman, Figure 12, column 30 lines 1-4; Nobakht, Figure 4).

32. Regarding claim 22, Reisman and Nobakht combined disclose a process of updating file in a database of a media content delivery system, said process comprising the steps of: receiving at the media content delivery system an integrated circuit card having encoded thereon criteria for selecting media files; receiving at the media content delivery system at least one media file; and storing in the database of the media content delivery system only media files received at the media content delivery system which meet the criteria on the integrated circuit card (Reisman, Figure 12, column 10 lines 52-67; Nobakht, Figures 2, 3B, 4, column 4 lines 51-65, column 5 lines 35-40, column 6 lines 34-49, column 8 line 64-column 9 line 10, column 9 lines 36-51, column 12 lines 50-65, column 7 lines 23-41).



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33. Regarding claim 23, Nobakht disclosed a process wherein step (b) comprises connecting the media content delivery system to an external data source, and receiving the at least one media file from the external data source (Figure 4).

34. Regarding claim 24, Reisman disclosed a process wherein step (b) comprises connecting the media content delivery system to the external data source by a wire connection (Figure 12, column 30 lines 1-4).

35. Regarding claim 25, Reisman disclosed a process as claimed in claim 23, wherein step (b) comprises connecting the media content delivery system to the external data source by a wireless connection (Figure 12, column 30 lines 1-4).

36. Regarding claim 26, Reisman disclosed a process wherein step (b) comprises connecting the media content delivery system to a server (Figure 12).

37. Regarding claim 27, Reisman disclosed a process wherein step (b) comprises connecting the media content delivery system to a computer (Figure 12).

38. Regarding claims 28-34, Reisman and Nobakht combined disclose a process wherein step (b) comprises receiving an audio file, a video file, a video game, a movie, a text file, a newspaper, e-mail file (Reisman, column 20 lines 31-42, column 22 lines 18-31, column 55 lines 53-58; Nobakht, Figure 3B, column 6 lines 13-14, column 8 line 64-column 9 line 10 ).

39. Regarding claim 35, Reisman disclosed a process wherein the media content delivery system includes a compact disc read only memory drive, and step (b) comprises inserting a compact disc read only memory into the compact disc read only memory drive, and receiving the at least one media file from the compact disc read only memory (column 1 lines 34-45, column 41 lines 3-14, column 42 lines 8-17).

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40. Regarding claim 36, Reisman disclosed a process wherein the media content delivery system includes a digital video disc drive, and step (b) comprises inserting a digital video disc into the digital video disc drive, and receiving the at least one media file from the digital video disc (column 41 lines 3-14, column 42 lines 8-17).

41. Regarding claim 37, Reisman disclosed a process wherein the media content delivery system includes a computer disk drive, and step (b) comprises inserting a computer disk into the computer disk drive, and receiving the at least one media file from the computer disk (Figure 12, column 41 lines 3-14, column 42 lines 8-17).

42. Regarding claim 38, Reisman disclosed a media content delivery system wherein the electronic interface comprises: a mobile wireless device [PDA] using a short-range communication link coupling the mobile wireless device to said database (column 1 line 63-column 2 line 8, column 11 lines 18-31).

43. Regarding claim 39, Reisman disclosed a mobile wireless device [PDA] using a short-range communication link coupling the mobile wireless device to said database (column 1 line 63-column 2 line 8, column 11 lines 18-31). Examiner takes Official Notice (see MPEP § 2144.03) that " wherein the mobile wireless device uses a *Bluetooth link* coupling the mobile wireless device to said database" in a computer networking environment was well known in the art at the time the invention was made as disclosed in Applicant Admitted Prior Art and other prior arts disclosed in the attached PTO-892 form. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its

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face a reasonable doubt regarding the circumstances justifying the judicial notice)."

Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

44. Regarding claim 40, Nobakht disclosed a media content delivery system wherein the criteria comprise: an identification of at least one type of file which may be accepted for storage in said database (Figure 3(B), column 8 line 64-column 9 line 10).

45. Regarding claims 41-45, the limitations of these claims are similar to the limitations of claim 40, and thus are rejected using the same rationale.

46. Since all the limitations of the claimed invention were disclosed by the combination of Reisman and Nobakht, claims 1-45 are rejected.

### ***Response to Arguments***

47. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

48. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

### ***Conclusion***

49. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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a. Borza (U.S. Patent Application Number 6,721,891) titled "Method of distributing piracy protected computer software" disclosed A method and a system for disabling execution of a software application stored within a computer absent data indicative of an authorized use of the software application are disclosed. At start up or during execution of a software application a user is prompted for user authorization information. Using a processor within a smart card the received user authorization information is compared with user authorization information stored in memory of the smart card to produce a comparison result. If the comparison result is indicative of an authorized user of the software application, then data indicative of the authorized use of the software application is provided from the smart card to the computer. Upon receipt of the data indicative of the authorized use of the software application execution of the software application is continued. When the data is not data indicative of the authorized use of the software application further execution of the software application is disabled.

b. Klaus (U.S. Patent Number 6,874,680) titled "Remote updating method and apparatus" disclosed a hand-held diagnostic tool designed to operate and easily upgrade software applications developed for automotive diagnostics. The diagnostic tool, which communicates with a plurality of motor vehicle control units, provides application upgrades and/or modifications and/or new algorithms that are developed/adapted via remote updating. Remote updating is accomplished through a number of external ports on the tool that facilitate modem, Ethernet and wireless communications, including point-to-point protocol connection to the Internet. one verification criteria is the existence of a valid smart card. Another verification criteria is the existence of a valid application record stored on the internal hard drive of the tool. Upon successful verification, the requested diagnostic application(s) is/are retrieved, and the application upgrade/modification is automatically downloaded or installed on the tool.

50. Refer to the enclosed PTO-892 for details.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (571) 272-3930. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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June 8, 2005